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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,845	03/30/2004	Christophe Gauthier	116598-00114	2328
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BLANK ROME LLP 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			EXAMINER	
			HINZE, LEO T	
			ART UNIT	PAPER NUMBER
			2854	
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			03/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/811,845

Applicant(s)

GOUTHIER ET AL.

Examiner

LEO T. HINZE

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-10 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10, 13-17 and 20 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 01 February 2008 have been fully considered but they are not persuasive.
2. Applicant argues on p. 6 that the amendments to claims 1 and 10 make it clear that *an* image is not displayed by the present dial under normal lighting conditions, and that the claims require that *no* image is visible at all on the dial. The examiner disagrees. As recited in claims 1 and 10, the first instance of "image" appears to refer to an image formed by phosphorescent, fluorescent, or luminescent elements. The second instance of "image" therefore appears only to refer to the specific image formed by the phosphorescent, fluorescent, or luminescent elements. Consequently, the examiner believes that a reasonable interpretation of the language of claims 1 and 10 would be that only the image formed by the phosphorescent, fluorescent, or luminescent elements is not visible under normal lighting conditions.
 - a. Contrasting Lange with the inventions in claims 1 and 10, the examiner considers Lange to teach two separate images. One image is formed by the luminescent body 20 (Fig. 12) of Lange. The second image is formed by the semi-transparent reflective layer 30 (Fig. 12) of Lange. The two images taught by Lange appear to be coincident, with the image formed by the semi-transparent reflective layer 30 superimposed over the image formed by the luminescent body 20. Due to this arrangement, the image formed by the luminescent body 20 is not visible under normal lighting conditions, while the

corresponding image formed by the semi-transparent reflective layer 30 is visible under normal lighting conditions. The examiner's rebuttal also applies to new independent claim 15.

3. Applicant alleges on pp. 6-7 that claims 13 and 14 clarify that the semi-transparent layer does not form an image that is visible under normal lighting conditions. The examiner disagrees that the language of claims 13 and 14 clarifies that no "image" is formed by the semi-transparent layer under normal lighting conditions. Further discussion is contained below in the rejection of claims 13 and 14 under 35 U.S.C. § 112.

Claim Objections

4. Claims 18 and 19 are objected to because of the following informalities: a claim depending from a claim which uses the transitional phrase "consisting of" may not add any steps or elements to the claimed invention. See MPEP § 2111.03.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Both claims recite the limitation that said semi-transparent layer does not form an image that is visible under normal lighting. This

would seem to imply that the semi-transparent layer is not visible, or invisible, under normal lighting conditions, as the online version of Merriam-Webster defines an image as “a tangible or visible representation.” It seems clear from the specification that the invention requires that the semi-transparent layer be visible, i.e. form an image, under normal lighting conditions. The image formed by the semi-transparent layer may hide the image formed by the luminous layer under normal lighting conditions. The contradictory nature of the of the claim terms, particularly when compared with the specification, renders the scope of the claim indefinite.

Because the indefinite nature of the claim has made it difficult for the examiner to ascertain the scope of the claim, no art has been applied.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 4-10, 15-17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lange, US 2,885,561 (hereinafter Lange).

a. Regarding claims 1 and 10, Lange teaches a dial, comprising: a substrate plate (45, Fig. 12); a semi-transparent layer (17, 30, Fig. 12) covering at least part of said substrate plate of a material allowing light to pass; phosphorescent, fluorescent or

luminescent luminous elements (20, Fig. 12) lodged between said substrate plate and said semi-transparent layer to form an image that is visible in darkness; wherein no image is visible under normal lighting conditions (col. 1, ll. 38-45), and wherein said luminous elements are lodged in blind hollows made in said semi-transparent layer and open towards said substrate plate (see Fig. 12).

b. Regarding claim 4, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also appears to teach the same structure that would result if said luminous elements were applied by serigraphy, tampography or manually onto said substrate plate and/or onto said semi-transparent layer. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

c. Regarding claim 5, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also teaches wherein said semi-transparent layer is made of plastic ("synthetic resin," col. 5, ll. 1-2).

d. Regarding claim 6, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also teaches a colored layer (30, Fig. 12) interposed between said substrate plate and said semi-transparent layer.

e. Regarding claim 7, Lange teaches the dial of claim 6 as discussed in the rejection of claim 6 above. Lange also teaches wherein said colored layer is a coat of varnish ("translucent brilliant varnish base," col. 3, ll. 4-5).

f. Regarding claim 8, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also appears to teach the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

g. Regarding claim 9, Lange teaches the dial of claim 1 as discussed in the rejection of claim 1 above. Lange also appears to teach the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

h. Regarding claim 15, Lange teaches a dial consisting of: a substrate plate (45, Fig. 12); a semi-transparent layer (17, 30, Fig. 12) covering at least part of said substrate plate of a material allowing light to pass; phosphorescent, fluorescent or luminescent luminous elements (20, Fig. 12) lodged between said substrate plate and said semi-transparent layer; wherein said luminous elements form an image, and the image that is visible in darkness but essentially invisible under normal lighting conditions (col. 1, ll. 38-45), and wherein said luminous elements are lodged in blind hollows made in said semi-transparent layer and open toward said substrate plate (see Fig. 12).

i. Regarding claim 16, Lange teaches the dial of claim 15 as discussed in the rejection of claim 15 above. Lange also appears to teach the same structure that would result if said luminous elements were applied by serigraphy, tampography or manually onto said substrate plate and/or onto said semi-transparent layer. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

j. Regarding claim 17, Lange teaches the dial of claim 15 as discussed in the rejection of claim 15 above. Lange also teaches wherein said semi-transparent layer is made of plastic ("synthetic resin," col. 5, ll. 1-2).

k. Regarding claim 20, Lange teaches the dial of claim 15 as discussed in the rejection of claim 15 above. Lange also appears to teach the same structure that would result if said blind hollows were made by machining or by selective chemical attack. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.0

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is 571.272.2864. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571.272.2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Judy Nguyen/

Supervisory Patent Examiner, Art Unit 2854

Leo T. Hinze
Patent Examiner
AU 2854
04 March 2008